

REMARKS

The rejection of claims 1-9 under 35 USC 103(a) as being obvious over U.S. Patent No. 5,451,449 to Shetty et al. in view of U.S. Patent No. 6,459,514 to Gilbert et al. has been withdrawn as per Paper No. 9, dated April 10, 2003.

Claims 1-9 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. 5,451,449 to Shetty et al. in view of U.S. Patent No. 6,459,514 to Gilbert et al. The Examiner has stated that although the conflicting claims are not identical, they are not patentably distinct from each other. The Examiner states that the instant application claims a uniaxial oriented multilayered film, while the Shetty reference claims a film that has not been so oriented. The Examiner states that however it would have been obvious to one of ordinary skill in the art to make a uniaxial oriented multilayered film having the claimed tensile strength since Gilbert teaches that it is known to uniaxially stretch or orient a coextruded multilayered iridescent film. The Examiner states that a multilayered iridescent film having the claimed tensile strength is optimizable, especially since the film has the same thickness as applicant claims. The rejection is respectfully but strongly traversed.

The Examiner is correct that Shetty claims a transparent thermoplastic laminate film containing multilayers. What Shetty does not claim is that the film is uniaxially oriented, nor does Shetty claim the ultimate tensile strength at break "of about 2.5 to 9 kgf" as recited in claim 1, nor the ultimate tensile at break "of about 4.5 to 7 kgf" as recited in claim 2. Shetty also does not claim the subject matter set forth in instant claim 9 wherein the film is in the form of a microfilament thread having a specified width. To conclude that the instant claims which recite not only tensile strength values, but thickness values and the physical property of being "uniaxially oriented," none of which

limitations are present in Shetty et al., essentially claim the same subject matter as Shetty et al. and unfairly extend the monopoly of the Shetty et al. claims is untenable.

The Examiner makes up for the deficiencies in the Shetty et al. claims by stating that Gilbert teaches it is known to uniaxially stretch or orient a coextruded multilayered iridescent film. However, Gilbert does not disclose “iridescent” films. Gilbert discloses multilayer optical stacks such as for acting as reflective polarizers or mirrors.

Importantly, while Gilbert discloses uniaxially orienting a multilayered optical film such as disclosed in column 3, lines 46-57, Gilbert stretches the film to alter the optical properties, and does not make a single reference to improving the mechanical properties of the film, including improving the ultimate tensile strength at break such as claimed. It would not be obvious to modify the claimed invention of Shetty et al. to orient the film to achieve the claimed tensile strength as specified by the ranges set forth in claims 1 and 2 in as much as Gilbert does not remotely suggest orienting the film to improve the tensile strength thereof. Accordingly, Gilbert cannot suggest optimizing tensile strength to the claimed values when the patent is totally silent regarding the relationship between orienting the film and the strength of the film which is achieved. Gilbert is only concerned with orienting the film to alter the refractive index of the film as disclosed in column 2, lines 9-27.

In fact, Gilbert teaches away from strengthening the film by stretching. The Examiner will kindly note that Gilbert clearly states in column 11, lines 7-17, that while the multilayer optical stacks as described in the invention provide desirable optical properties, other properties such as mechanical properties are difficult to provide in the optical stack itself without degrading the performance of the optical stack. Gilbert understood that orienting a film to improve one set of properties may be detrimental to others. What Gilbert does not suggest is that the multilayered iridescent films of the

claimed invention, having the claimed thickness and being uniaxially orientated, can provide an iridescent decorative film having the improved tensile strength values as recited.

Further, Gilbert is not concerned with the films as claimed. The films of Gilbert are substantially thicker than 0.007 to 0.034 mm as recited in the instant claims. The Examiner is kindly invited to the examples in Gilbert which are the only indication of the thickness of the films which are formed by the Gilbert process. The Examiner is kindly invited to Example 4 of Gilbert, where a finished film had a thickness of 2 mils. Such thickness equates to 0.051 millimeters, which is outside the range set forth in claim 1. The other examples disclose even thicker films. Even Shetty et al. does not specifically claim the thickness range which is set out in claim 1.

Further, with respect to claim 9 of the instant application, which in fact recites an iridescent film in the form of a microfilament thread, the Examiner states that Shetty provides the same film, and that a film formed in a thread having the aforesaid width is not in itself considered to be a matter of invention. These comments by the Examiner are not well taken. Claim 9 is directed to a particular structure of the iridescent film. Such structure is not remotely recited in the claims of Shetty et al. The Examiner simply cannot ignore a limitation of structure, in particular in an article claim. The claimed iridescent film in the form of a microfilament thread is not an optimization of the laminate films recited in the Shetty et al. claims. Claim 9 clearly recites a distinct article.

In response to Applicant's arguments, the Examiner states that mechanical test properties such as tensile at strength are optimizable, and are result effective variables. A tensile strength value is naturally present when the same thickness and materials are provided. As stated previously, Gilbert does not teach a film of the claimed thickness,

but teaches films having thicknesses outside the scope of the claimed thickness. As previously argued, in as much as Gilbert does not teach a tensile strength, a particular tensile strength value or value range cannot be optimized from the teachings of Gilbert. There is no suggestion whatsoever in Gilbert to optimize the orientation to achieve the claimed ultimate tensile strength values as set forth in the instant claims. One cannot optimize something which is not disclosed. The Examiner apparently is relying on inherency. Rejections based on inherency require that the applied reference necessarily meets the claimed limitation, not that it might or possibly meet the claimed limitations. See *Continental Can Co. USA Inc. v. Monsanto Co.*, 20 USPQ2d, 1756, 1749 (CAFC, 1991):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by people of ordinary skill.

*In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA) 1939)) provides:

Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Also, *Rosco Inc. v. Mirror Lite Company*, 64 USPQ 2d, 1676, (CAFC 2002) states:

Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibility present, in the prior art.

There is no suggestion whatsoever in Gilbert that films of the claimed thickness can be uniaxially oriented and necessarily achieve the claimed tensile strength value range of

“2.5 to 9 kgf” which is recited. Moreover, the claimed tensile strength is not “necessarily present” in the process of Gilbert, nor would it be so recognized by those of ordinary skill in the art.

Applicant has also argued that the reason for stretching the film of Gilbert is not present in either Shetty or the instant invention. The Examiner concludes that the reason for orienting in Gilbert does not have to be present in Shetty, and that the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. The Examiner states that it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. However, applicants are not claiming merely a uniaxially oriented film or a generalized improvement in tensile strength. Applicants are claiming a specific tensile strength, i.e. 2.5 to 9 kgf, achieved by uniaxially orienting a film, which after stretching has a specified thickness, i.e. 0.007 to 0.034 mm. There is no suggestion whatsoever in Gilbert that a film of the claimed thickness can be achieved by uniaxially orienting and further have the claimed tensile strength values. Gilbert does not teach the claimed thickness, and cannot suggest orienting to achieve the claimed tensile strength in the absence of any relationship between film thickness, orientation, and tensile strength.

The Examiner states that tensile strength is a common property obtained from a mechanical test. The statement is not understood. Tensile strength is not obtained from a mechanical test, but is measured by a mechanical test. The tensile strength is improved by the orientation of the film. The Examiner has absolutely no way of knowing whether the films of Gilbert would have improved tensile strength in general. In fact, Gilbert states in column 11, lines 7-17 that other steps are needed to improve mechanical properties. Gilbert suggests that he must add thicker skin layers to the



Graney  
4649

oriented film to achieve desired mechanical properties. The claimed invention is not directed to merely "improving" tensile strength, in general. The claimed invention is directed to a multilayered film having a particular thickness, which has a particular tensile strength. It cannot be considered experimental modification of the prior art to achieve the claimed strength values when the applied prior art does not disclose the relationship between orientating a multilayer thin film and improving tensile strength. Again, it cannot be mere optimization when a particular film thickness and a particular film tensile strength are claimed and the reference which the Examiner is relying on to meet the claim limitations discloses neither of the claimed values or importance of same. Accordingly, it is respectfully requested that the rejection based on obviousness-type double patenting be withdrawn.

For the reasons as expressed above, it is believed that claims 1-9 patentably distinguish over the art of record, and applicants respectfully solicit such favorable action.

Jan 23, 2004  
Date

Respectfully submitted,

Stuart D. Frenkel  
Reg. No. 29,500

Law Office of Stuart D. Frenkel, P.C.  
3975 University Drive, Suite 330  
Fairfax, VA 22030  
Telephone (703) 246-9641  
Facsimile (703) 246-9646